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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,381	03/22/2000	Nicola Fanto	2801-14	8341

7590 01/15/2004

NIXON AND VANDEHYDE, P.C.  
1100 North Glebe Road, 8th. Floor  
Arlington, VA 22201

EXAMINER

BARTS, SAMUEL A

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/533,381	03/22/2000	Nicola Fanto	2801-14	8341

7590 06/17/2003

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EXAMINER

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25

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*Noted - 1/14/04*

**Office Action Summary**

Application No.

09/533,381

Applicant(s)

FANTO ET AL.

Examiner

Samuel A Barts

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other:

DETAILED ACTION

*Response to Arguments*

1. Applicant's amendment to the claims filed March 26, 2003 has obviated the rejection of the previous office action.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

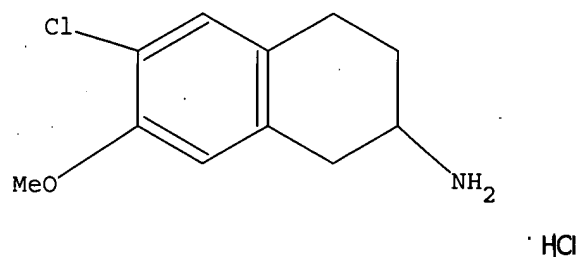
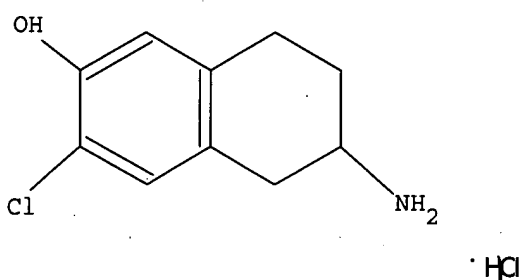
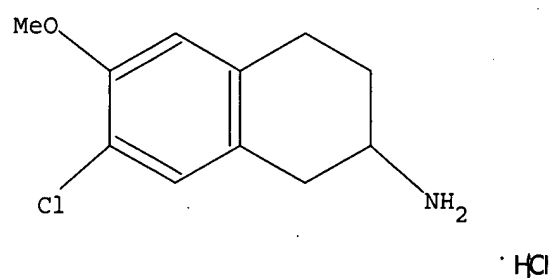
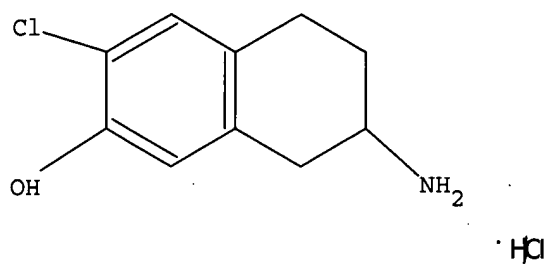
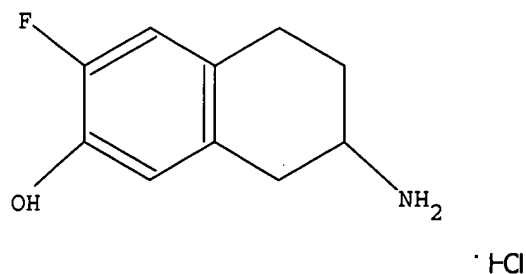
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8, 9, and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Weinstock et al (J. Med. Chem. 1986, vol 29, pages 1615-1627).

Weinstock et al teach the following compounds:

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See table I page 1617(4h, 4l and 4u) and Table II on page 1618(compounds 34c and 34 l)

The instant claims read on the compounds taught in Weinstock et al when R=halogen (Cl or F), R<sub>1</sub>= OH, and R<sub>2</sub>= hydrogen; when R=OH, R<sub>1</sub>=halogen (Cl) and R<sub>2</sub>= hydrogen; when R=halogen (Cl), R<sub>1</sub>=OCH<sub>3</sub>, and R<sub>2</sub>= hydrogen and when R=OCH<sub>3</sub>, R<sub>1</sub>= halogen (Cl), and R<sub>2</sub>= hydrogen.

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Claim 11 is also anticipated because the above compounds were all made in the prior art of Weinstock et al and the final compositions read inherently on an "orally or parenterally administrable pharmaceutical composition".

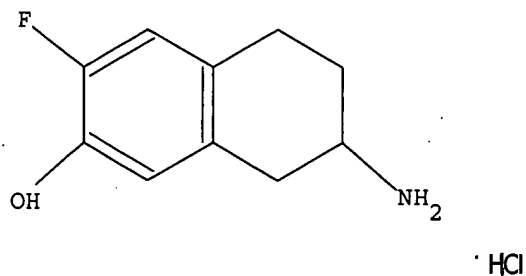
*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstock et al (J.Med Chem. 1986, vol 29, pages 1615-1627).

Weinstock et al teach the compound 2-amino-6-fluoro-7-hydroxytetraline hydrochloride.



Weinstock et al is silent about the optical isomers. However, the structure has a chiral center and therefore, will inherently have the optical isomers in equal amounts (i.e. the compound is a racemate). The compositions made in

Weinstock et al are racemic mixtures of the first two claimed compounds of claim 10. The compounds are useful as dopaminergic agents.

The difference between the claimed invention and the prior art is that claimed invention is directed to the optical isomers of 2-amino-6-fluoro-7-hydroxytetraline hydrochloride. This difference is not patentable.

It would have been obvious to one having ordinary skill in the art at the time that applicant's invention was made to have isolated the optical isomers of 2-amino-6-fluoro-7-hydroxytetraline hydrochloride with a reasonable expectation that one of the isomers would have the dominant pharmacological activity. One skilled in the art would be motivated to isolate the optical isomers in order to make more potent dopaminergic active compositions. Additional motivation lies in the fact, that there is a reasonable expectation that the side effects usually associated with the racemic mixture can be eliminated if they are the result of the optical isomer that is not responsible for the desired pharmacological activity.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 703-308-4630. The examiner can normally be reached on 6:30-3:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johan Richter can be reached on 308-1235. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



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Samuel A Barts  
Primary Examiner  
Art Unit 1621

s.b.  
June 13, 2003